SUPREME COURT, U. S.
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In the Supreme Court

OF THE

United States

OCTOBER TERM, 1967

No. 377

CARL S. ZILK and FLOMATIC SALES CORPORATION, an Oregon corporation,
Petitioners,

vs.

DEATON'S FOUNTAIN SERVICE, a partnership comprised of William P. Deaton and C. J. De Ceasare,
Respondent.

PETITION FOR THE WRIT OF CERTIORARI
to the United States Court of Appeals
for the Ninth Circuit

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Petitioners pray that the writ of certiorari issue to review the judgment of the United States Court of Appeals for the Ninth Circuit entered in this cause on April 19, 1967.

OPINIONS BELOW

The opinion of the Court of Appeals made on April 19, 1967 is reported at ..... F.2d ....., 153 P.Q. 386 and is reprinted in the Appendix, page 1a. The opinion of the District Court is reported at 257 F.Supp. 458, 149 P.Q. 594 and is reprinted in the Appendix, page 4a.

JURISDICTION

The judgment of the Court of Appeals was entered on April 19, 1967 [R. 288, App. 3a]. Jurisdiction of this Court is invoked under 28 U.S.C. 1254(1). Jurisdiction in the District Court was based upon 28 U.S.C. 1338(a).

QUESTIONS PRESENTED

The jury, by special verdict, found that the patented subject matter was not obvious. The District Court recognized there were differences between the patented device and the prior art, that there was an unsatisfied need, that the patented device attained commercial success, that the most pertinent prior art devices were generally abandoned in favor of the patented device and its progeny when they became available on the market, and that a small amount of objective evidence of non-obviousness was tendered. In such a setting—

1. Under the Seventh Amendment to the Constitution and under the decisions of this Court in cases exemplified by *Myers v. Reading Co.* (1947), 331 U.S. 477 and *Keyes v. Grant* (1886), 118 U.S. 25, does a District Court have

the power to find obvious subject matter and thus to deprive a patentee of a jury verdict for damages arising from patent infringment?

2. Is the question of obvious subject matter under U.S. Code, Title 35, Section 103 a question of fact which should be resolved by the jury under the Seventh Amendment to the Constitution or is it a question of law to be determined by the Court on a motion for judgment notwithstanding the verdict?

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Article VII in addition to, and amendment of, the Constitution of the United States of America, to wit:

> "In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any Court of the United States, than according to the rules of the common law."

35 U.S.C. 103, which provides:

> "A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

35 U.S.C. 281, which provides:

> "A patentee shall have remedy by civil action for infringement of his patent."

That part of 35 U.S.C. 282, which provides:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

STATEMENT OF THE CASE

This action for damages arising from respondent's alleged infringement of petitioners' patent No. 2,887,254 for Dispensing Apparatus was brought under the patent laws of the United States pursuant to 28 U.S.C. 1338(a) and 35 U.S.C. 281, and was tried to the jury. After the conclusion of the evidence, respondent moved for a directed verdict in its favor (App. 4a). This motion was denied and the jury found in favor of the petitioners and awarded damages (App. 4a, 14a). Respondent's subsequent motion for judgment notwithstanding the verdict was granted (App. 4a-13a). The Court of Appeals for the Ninth Circuit affirmed the judgment (App. 3a). This petition seeks review of that judgment.

In the words of the District Court, the patented device is an apparatus for dispensing a plurality of bar mixes including soda and flavored soft drinks (App. 5a). The patented device includes a dispensing head which is attached to one end of a flexible hose. Finger operated electrical push buttons on the head actuate valve means mounted on the bar to supply any one of several different bar mixes to the head. By depressing a push button on the

head, an operator can with one hand dispense one or several bar mixes from the nozzle on the head into a drink glass (App. 5a).

One of the foremost prior art devices is the Bar-Master "Magic Wand." This bar dispenser had a valve block and a series of electrical switch push buttons mounted on the bar (App. 8a). The bartender, in a two-handed operation, had to depress the designated electrical button with one hand and had to grip the movable head with the other to dispense any one of a plurality of mixes (App. 8a-9a).

Another prior art dispenser known as "Speed Bar" or "Wheco" had a beverage dispensing head in which a valve handle was mounted on the head to permit the user to control a single beverage with the hand that held the dispensing head. With this device, the bartender could dispense only soda or some other single flavor or beverage from each handle. Thus he had to manipulate additional hoses to dispense more than one beverage (App. 9a).

In essence, the Zilk patented device distinguished from the prior art devices in the one-handed selective dispensing of a plurality of fluids without the necessity of changing the grip of that hand (App. 10a). Yet it still provided for the valve block remotely located from the head down the line to the flavored beverages. Once this arrangement was conceived, the mechanical changes required were simple (App. 11a). First, as the District Court pointed out, the push buttons were trimmed in size and regrouped in a manner to accommodate the function of one-handed operation without change of grip. This was not possible with the larger push button on the "Magic Wand" (App. 9a-10a). Second, the electrical switches were made more

compact and relocated with electrical wiring running along the hose to the switches (App. 10a). Third, means were provided to hold the conduits and flexible conductors together in contiguous fashion (App. 10a).

In addition to these two principal prior art structures, the District Court referred to peripheral prior art including patents to Buttner, Lingard, Carter, Brown and Miller (App. 9a, 11a).

The District Court found that there was "evidence of unsatisfied need and the commercial success of the Zilk patented device", that there was "testimony that the 'Wheco' and 'Bar-Master' devices were generally abandoned in favor of the Zilk device and its progeny when they became available on the market" and that "a small amount of objective evidence of non-obviousness was tendered" (App. 12a).

At the close of evidence, the District Court denied respondent's motion for a directed verdict (App. 5a) and instructed the jury most thoughtfully and carefully on the principles of law to be applied in appraising the worth of the Zilk patent (App. 20a-46a). The District Court instructed the jury especially as to obvious subject matter (App. 35a-36a). The District Court submitted to the jury special interrogatories directed both to the novelty of petitioners' combination and to its obviousness and required separate answers with regard to each claim of the patent (App. 15a-18a).

The jury, in its turn, unanimously found that the combination of elements recited in the patent claims were not "anywhere disclosed in the prior art" and answered "no" to the questions as to whether the improvement or advance

made by the patentee in his combination would have been obvious to one of ordinary skill with respect to each claim in suit (App. 15a-18a).

After the jury verdict came down, the District Court made its own independent re-appraisal of the evidence and reached the following conclusions:

> ". . . The differences in the Zilk patent were insubstantial and unpatentable . . . ." (App. 12a).
>
> ". . . the jury was unreasonable in finding that the Zilk patent was nonobvious. . . ." (App. 12a).

As a consequence of these views, vis-a-vis the standard of 35 U.S.C. 103, the Court concluded that the Zilk patent is invalid as a matter of law in that it clearly does not meet the statutory mandates (App. 12a).

On review, the Court of Appeals was of the view (App. 1a) that the District Court applied the standard of *Brady v. Southern Ry. Co.* (1943), 320 U.S. 476, quoting from 479-480, as follows:

> ". . . When the evidence is such that without weighing the credibility of the witnesses there can be but one reasonable conclusion as to the verdict, the court should determine the proceeding . . . by judgment notwithstanding the verdict. . . ."

As a consequence the Court of Appeals affirmed the judgment for failure to comply with 35 U.S.C. 103 (App. 2a).

REASONS FOR GRANTING THE WRIT

As a preliminary to stating our reasons for asking this Court to take review, we submit that the record furnishes an evidentiary basis upon which reasonable men could conclude the presence of invention. As proof of this, we need only refer to *Goodyear Co. v. Ray-O-Vac Co.* (1944), 321 U.S. 275. There, upon a record containing evidence substantially analogous to that which the District Court recognized as being present here, patentable invention was upheld. At page 279, this Court noted:

> "Viewed after the event, the means Anthony adopted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention. . . ."

Thus, the standard is not whether the invention should have been obvious, it is whether it was obvious in fact. With this preface, we urge—

1. In disregarding affirmative evidence supporting the verdict and treating the issue of obviousness as a question of law, the decisions below are in conflict with applicable decisions of this Court such as *Keyes v. Grant* (1886), 118 U.S. 25 and *Myers v. Reading Co.* (1947), 331 U.S. 477.

The general principle applicable to all cases—and overriding the rhetoric of *Brady v. Southern Ry. Co.* (1943), 320 U.S. 476, which the Court of Appeals applied (App. 1a-2a)—is the formula used by this Court in the cases collected and analyzed in *Myers v. Reading Co.* (1947), 331 U.S. 477 at page 485. That formula, distilled at page 485, is:

> ". . . The requirement is for probative facts capable of supporting, with reason, the conclusion expressed in the verdict."

This Court, in *Myers*, confirmed by quotation from *Lavender v. Kurn* (1946), 327 U.S. 645, that a court has no right to make an independent determination as to the reasonableness of the verdict. Quoting from 327 U.S. 653, this Court pointed out, page 486:

> "... the appellate court's function is exhausted when that evidentiary basis becomes apparent, it being immaterial that the court might draw a contrary inference or feel that another conclusion is more reasonable."

In *Myers*, this Court reinstated a jury verdict for the plaintiff in a Federal Employers' Liability Act case. But the general principles applied in ordinary tort cases are, we submit, under the authority of *Keyes v. Grant* (1886), 118 U.S. 25, equally applicable to the question of invention in patent infringement actions. Where there are differences between the prior art and the patented device, that case holds that invention is "a question of fact properly to be left for determination to the jury, under suitable instructions from the court upon the rules of law, which should guide them to their verdict." (page 37). This because, page 36:

> "... So that it certainly was not a matter of mere judicial knowledge, that these differences were either not material in any degree to the result, or, if material at all, were only such as would not require the exercise of the faculty of invention, but would be suggested by the skill of an experienced workman employed to produce the best result in the application of the well-known arrangements of the furnace. ..."

Thus, we submit that the action of the courts below in depriving petitioners of their jury verdict preserved by

the Seventh Amendment is in square conflict with the standards of common law review announced by this Court and applied in *Myers* and *Keyes*.

2. The question of whether a party has been deprived of his right to a jury trial is an important one which transcends the rights of the particular litigants and warrants the intervention of this Court. The right to a jury trial is fundamental to our jurisprudence. As early as *Parsons v. Bedford* (1830), 3 Pet. (28 U.S.) 433, Mr. Justice Story, delivering the opinion for the Court, said, page 446:

> "The trial by jury is justly dear to the American people. It has always been an object of deep interest and solicitude, and every encroachment upon it has been watched with great jealousy. . . ."

More recently, in *Jacob v. New York* (1942), 315 U.S. 752, Mr. Justice Murphy, delivering the opinion for the Court, said, page 752:

> "The right of jury trial in civil cases at common law is a basic and fundamental feature of our system of federal jurisprudence which is protected by the Seventh Amendment. A right so fundamental and sacred to the citizen, whether guaranteed by the Constitution or provided by statute, should be jealously guarded by the courts. . . ."

Patent cases are not in a class by themselves in this regard. In *Root v. Railway Co.* (1881), 105 U.S. 189, at page 206, this Court noted:

> ". . . the seventh amendment forbids any infringement of the right of trial by jury, as fixed by the common law. And the doctrine applies in patent cases as well as others. . . ."

3. Apart from the Constitution and the precedents, this Court should, petitioners submit, encourage both litigants and the lower courts alike to return to what was once almost a universal practice of trying validity and infringement issues to the jury. The content of the masses of petitions for the writ of certiorari presented to this Court makes it abundantly clear that by and large questions of invention depend upon factual conclusions and inferences based upon an appraisal of what the patentee did in the light of the available public knowledge. A jury of one's peers is far closer to the motivations, influences and thought processes which bring about new developments, we submit, than a court can ever be. By training and by intellectual acuity, a well-qualified judge is far apart from, and far above the level of, the "person having ordinary skill in the art." On the other hand, the jury being composed of ordinary folks is a part of, and on the same level as, the person of ordinary skill whose efforts are being equated.

Recognition that these questions are essentially jury questions must have been latent in this Court's caveat in *Graham v. John Deere Co.* (1966), 383 U.S. 1, at page 18:

> "This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. . . ."

We submit that by the grant of the writ of certiorari in this case, and the return to Constitutional fundamentals,

those difficulties can be, and well they should be, resolved by the jury in patent cases as they are in cases of negligence and scienter.

4. Patentees, as a class, truly need the interposition of this Court if their Constitutional right to a jury trial is to be "preserved" as required by the Seventh Amendment. We have made a diligent effort to locate and to examine every reported patent infringement case involving either the patentee's or the putative infringer's right to a jury verdict in the past 15 years, and have collected such cases in a schedule attached to this petition (App. 47a-52a). In summary, that schedule shows that patentees were deprived of a jury verdict on any one of a number of different levels in a total of 19 cases and that patentees were awarded judgment pursuant to the jury verdict in only 3 cases. It cannot be, we submit, that juries are so inept that they are incapable of reaching a proper conclusion in 86% of the cases which are within their Constitutional prerogative.

Patent litigation, we submit, manifests the same reticence of the courts to accept the jury verdict as does the other tort litigation which has so rightfully required the interposition of this Court [*Wilkerson v. McCarthy* (1949), 336 U.S. 53, 55, 68-71; and *Rogers v. Missouri Pacific R. Co.* (1957), 352 U.S. 500, 509-510]. We submit, most respectfully, that patent litigants should be guaranteed their Constitutional right to trial by jury. Fifteen years history proves that this Court cannot rely upon the lower courts to enforce that guaranty.

For the foregoing reasons, it is submitted that this petition for the writ of certiorari should be granted.

Respectfully submitted,

CARL HOPPE,

JAMES F. MITCHELL,

Attorneys for Petitioners.

(Appendix Follows)

Appendix

United States Court of Appeals
For The Ninth Circuit

Carl S. Zilk, et al., Appellants, vs. Deaton's Fountain Service, et al., Appellees.	No. 21,194

[April 19, 1967]

Appeal from the United States District Court
for the Northern District of California
Southern Division

Before: JERTBERG and BROWNING, Circuit Judges, and TAYLOR, District Judge

PER CURIAM:

The district court held invalid Patent No. 2,887,250 issued to Carl Zilk on May 19, 1959, and entered a judgment to that effect on appellees' motion, notwithstanding a jury verdict to the contrary. As we read the opinion of the district court, it applied the standard of *Brady v. Southern R.R.*, 320 U.S. 476, 479-80 (1943), that "When the evidence is such that without weighing the credibility of the witnesses there can be but one reasonable conclusion as to the verdict, the court should determine the pro-

ceeding * * * by judgment notwithstanding the verdict." We have examined the record and agree that the uncontradicted evidence requires the conclusion that "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C.A. § 103.

Affirmed.

United States Court of Appeals
For The Ninth Circuit

Carl S. Zilk, et al., Appellants, vs. Deaton's Fountain Service, et al., Appellees.	No. 21,194

Appeal from the United States District Court for the Northern District of California, Southern Division.

This Cause came on to be heard on the Transcript of the Record from the United States District Court for the Northern District of California, Southern Division and was duly submitted.

On Consideration Whereof, It is now here ordered and adjudged by this Court, that the judgment of the said District Court in this Cause be, and hereby is Affirmed.
Filed and entered April 19, 1967

In The United States District Court For The Northern District of California, Southern Division

Carl S. Zilk and Flomatic Sales Corporation, an Oregon corporation, Plaintiffs, vs. Deaton's Fountain Service, a partnership comprised of William F. Deaton and C. J. DeCeasare, and United California Bank, Defendants.	No. 41,150

MEMORANDUM OPINION AND ORDER GRANTING DEFENDANTS' MOTION FOR JUDGMENT NOTWITHSTANDING THE VERDICT.

This patent infringement suit was tried before a jury. After the conclusion of the evidence, defendant moved pursuant to F.R.C.P. 50(a) for a directed verdict in its favor on the ground that the patent in suit was invalid as a matter of law. Defendants' motion for directed verdict was denied and the case submitted to the jury, because the Court believed that the legal issues raised warranted a thorough study which could be made more carefully, if necessary, upon a motion for judgment notwithstanding the verdict. *Stallman v. Casey Bearing Co.*, 144 F.Supp. 927 (1956). The jury subsequently found in favor of the plaintiff and awarded damages. Defendant thereafter timely filed a motion for judgment n.o.v. pursuant to F.R.C.P. 50(b). An appraisal of the entire record in the light of the oral and written argument upon

the motion combined with a careful consideration of the recent Supreme Court decision in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and the more recent Ninth Circuit decision in *Brooks Walker v. General Motors Corp.* (April 19, 1966) Civil No. 19242 [not yet reported] (both decisions rendered subsequent to the trial in this action) compels the conclusion that the patent in suit is invalid as a matter of law and that the jury verdict must be set aside and judgment entered for defendant. *Griffith Rubber Mills v. Hoffar,* (9th Cir. 1963) 313 F.2d 1.

The patent in suit, No. 2,887,250 is a bar dispensing apparatus issued to plaintiff, Carl Zilk on May 19, 1959 by the U. S. Patent Office. This application, Serial No. 695,870 for Dispensing Apparatus was filed November 12, 1957 by Plaintiff Zilk. The patent in suit (hereinafter "Zilk patent") is basicly an apparatus for dispensing a plurality of bar mixes including soda and flavored soft drinks such as 7-Up, Coca Cola, etc. The patented construction includes a dispensing head attached to one end of a flexible hose. Finger operated electrical push buttons on the head actuate bar mounted valve means to supply any one of several bar mixes to the head. By depressing a push button on the head an operator can with one hand dispense one or several bar mixes from a nozzle in the head into a drink glass.[1]

The defendants urge two major grounds for reversal of the jury's decision.[2] First of all, the defendants con-

[1]"It is the main object of the invention to provide a dispensing apparatus of the movable head type in which the valves may be controlled by the hand of the operator which supports the head." Zilk Patent No. 2,887,250, Plaintiff Ex. 1.

[2]Defendants included grounds for a new trial in their motion as an alternative motion.

tend that the Zilk patent does not meet the overall standard of invention established by the Supreme Court in 1950 in *A & P Tea Co. v. Supermarket Corp.*, 340 U.S. 147 and reaffirmed by its recent decision in *Graham v. John Deere, supra.*[3] In the *A & P Tea Co.* case the Supreme Court laid down the rule that the ultimate question of patent validity is one of law and that the legal standard for invention requires that where old elements are arranged in a new fashion the result must be *"unusual and surprising consequences"* (emphasis supplied). This Court agrees that as a matter of law and for reasons stated below, the Zilk invention fails to meet the general level of innovation necessary to sustain patentability. The patent in suit is therefore invalid. *Graham v. John Deere, supra,* p. 4; *A & P Co. v. Supermarket Corp., supra.*

Secondly and as a separate ground for reversal, defendants contend that the Zilk invention as a matter of law does not elude the obviousness hurdle established by 35 U.S.C. Section 103.[4] The issue of obviousness or non-

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[3]*Graham v. John Deere Co., supra* (1966) at p. 19: "Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be deemed with greater intensity on the requirements of §103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied. We have been urged to find in §103 a relaxed standard, supposedly a congressional reaction to the increased standard applied by this Court in its decision over the last 20 or 30 years. The standard has remained invariable in this Court." [The Court was referring to its cases applying the increased standard of which A & P Tea Co is a leading case.]

[4]35 U.S.C. Section 103 provides: "A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having

obviousness is basicly a question of fact (*Graham v. John Deere, supra* at p. 15) which the jury in this case determined in favor of the plaintiff on all eight claims. Special Interrogatories Nos. 2, 4, 6, 8, 10, 12, 14, 16. This Court is mindful of the deference due to a jury finding of non-obviousness.[5] However, a full review of the scope and content of the prior art on the claims at issue, and the level of ordinary skill in the art, lead this Court to the inescapable conclusion that no reasonable jury could have concluded that the Zilk invention was non-obvious to one skilled in the bar-dispensing art in July, 1957. Accordingly, the jury findings on the Section 103 issues must be set aside and resolved in favor of the defendant. *Griffith Rubber Mills v. Hoffar, supra, Cf. Brooks Walker v. General Motors, supra* (motion for summary judgment).[6] *Jungerson v. Ostby & Barton Co.*, 335 U.S. 560,

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ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

[5]Instruction No. 16 to the jury read as follows: "If you find that the differences between the claimed Zilk invention and the Wheco and Magic Wand devices are such that the claimed invention as a whole may have been obvious in July, 1957, to a person of ordinary skill in the bar dispensing art, you shall hold the Zilk patent invalid and return a verdict for defendants."

[6]In *Brooks Walker v. General Motors, supra,* Browning, J. made the following comment: "It is true that obviousness must be determined against a factual background. If the material facts are not disputed and if on these undisputed facts, the differences between the alleged invention and the prior art would have been obvious a summary judgment of invalidity for lack of invention is entirely proper." This Court recognizes that the standards for granting a summary judgment and judgment n.o.v. are different in degree. However, in both situations the judge must be convinced that no real disputable issue of fact exists. If the issue of obviousness or non-obviousness lends itself in certain cases to disposal by summary judgment, it follows that a judgment n.o.v. or directed verdict may likewise be appropriate in certain circumstances.

567, *Cee Bee Chem. Co. v. Delco Chemicals Inc.*, 263 F.2d at 153, *Cf. Monroe Auto Equipment Co. v. Heckethorn Mfg. Co.*, 332 F.2d 406 (6th Cir. 1964).

An explanation of the reasons for granting Defendants' motion for judgment n.o.v. on the dual grounds stated above, requires a survey of the prior art and a more thorough discussion of the Zilk patent in suit. The Supreme Court in *Graham v. John Deere Co., supra,* p. 17, sets out the guidelines for determination of issues under Section 103:

> "While the ultimate question of patent validity is one of law, *A & P Tea Co. v. Supermarket Corp., supra* at p. 155, the §103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under §103, the scope and content of the prior art are to be determined, differences between the prior art and the claims at issue are to be ascertained and the ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined."

The scope of the prior art in the bar-dispensing field was fully explored at trial and in the briefs submitted to the Court. Foremost of the prior art devices relied on by defendant is the Bar-Master "Magic Wand" Def. (Exhibit F-D) which Plaintiff Zilk had before him when he made the patented invention. The Magic Wand is a type of bar dispenser with a *bar-mounted* push button valve block incorporating a series of electrical switch buttons. (See appendix) By depressing the designated electrical button with one hand and grasping the movable head with the other, the bartender is able to dispense any

one of a plurality of mixes in a two handed operation. Additionally during the period prior to the Zilk invention in July, 1959, another beverage dispensing apparatus variously known as "Speed Bar" or "Wheco" dispenser was in use in the Portland area. (Defendants' Exhibit B, see Appendix.) The Speed Bar device included a beverage dispensing head in which a valve handle was mounted *on the head* to permit the user to control dispensing of a beverage with the hand that held the dispensing head.[8] However, the operator or bartender could dispense only soda or only a single flavored carbonated beverage from each handle. To dispense more than one, the operator was required to manipulate additional hoses.

The essence of plaintiffs' contention of validity is that the patented device (with a series of push buttons mounted on the flexible head) is a new combination of "old" elements which cooperate in a way to accomplish a result not obtained by any prior art dispenser; to wit, one-handed selective dispensing of a plurality of fluids *without* the necessity of changing the grip of that hand.

In addition to the functional improvement in operation (one-handed dispensing) plaintiff offered evidence and testimony intended to establish that the Zilk patent incorporated certain technical advancements over prior art dispensers such as "Wheco", "Speed Bar", and the "Magic Wand". The push buttons were trimmed in size

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[8]Defendant also cites a number of dispensing devices ranging from dishwashing gadgets to cleaning fluid dispensers in which operation buttons were mounted on the handle of a flexible hose so that the dispenser could be operated by the thumb of the hand which held the handle. e.g. Buttner Patent, Ex. 0-1, Lingard Patent Ex. 0-3, Lewis Patent, Ex. 0-9, etc. (non-cited patents).

and regrouped in a manner to accomplish the function of one handed operation without change of grip. (Not possible with the larger push button on the "Magic Wand" bar-mounted valve block.) Secondly, the electrical switches were made more compact and relocated along the hose with electrical wires running to said switches. Furthermore, means were provided whereby the conduits and flexible conductors were held together in contiguous fashion.[9]

In the final analysis, the only notable difference between the Zilk patented device and the prior art devices referred to, is the one-handed selective dispensing of a plurality of fluids without the necessity of changing the grip of that hand. The "Magic Wand" device dispensed a plurality of fluids from a bar-mounted valve block containing electrical push buttons. The "Wheco" or "Speed Bar" device dispensed a single fluid by depressing a valve handle mounted on the head. All that Zilk did was to conceive the idea of moving or relocating the switch buttons from their countermounted position on the "Magic Wand" to the handle at the end of the wand or flexible hose as had been done in the "Wheco" device with a single button. Even if the ordinary skill possessed by persons engaged in the bar-dispensing field were postulated at the minimum conceivable level, Zilk's dispensing

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[9]Claim 1 of the Zilk Patent includes the following elements ". . . said push-button being grouped on said handle to provide for operation of any push-button by a thumb or finger of said one hand of the operator without changing the grip of such one hand on the handle." ". . . switch means carried by said handle to control the supply of electrical energy to said power means." ". . . means holding said conduits and flexible conductors together in contiguous fashion." (Plaintiffs' Ex. 1.)

device would clearly have suggested itself as a possible solution to a person possessing such skill who was given the "Wheco" and "Magic Wand" device and told to alter it in such a way as to provide for one handed dispensing of a plurality of fluids. *Brooks Walker v. General Motors Corp., supra,* p. 5. The public is certainly entitled to the benefits, without paying monopoly prices, from such advances as normally flow from the application of the ordinary skills of one in the trade to the existing fund of public knowledge. *Griffith Rubber Mills v. Hoffar, supra.* It follows that though a device such as the Zilk patent may be a useful improvement, it is not patentable if it consists of no more than a combination of functions drawn from the existing fund of knowledge provided by the "Wheco", "Magic Wand", and other dispensing apparati.

The technical alterations once the idea was conceived were minor indeed. Plaintiff conceded in its brief that the Zilk device was "not difficult to build once it was conceived." (Plaintiffs' memorandum in opposition to defendants' motion for judgment n.o.v., p. 2.) There was no inventive distinction in trimming the push button size, or running the electrical wires along the hose, or in relocating the electrical switches instead of the valves themselves.[10] The prior art as a whole clearly taught that valve buttons and valve switches could be mounted on the handles of wand type dispensers to make the dispensers

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[10]The prior art in other types of dispensers teaches the technique of relocating electrical switches onto the wand of the dispenser and running wires thereto. Carter Patent (Def. Ex. 0-2), Brown Patent (Def. Ex. M), Miller Patent, (Ex. 0-7) (Carter and Miller patents non-cited).

easier to use. The differences in the Zilk patent were insubstantial and unpatentable. Plaintiff did offer evidence of unsatisfied need and the commercial success of the Zilk patented device. There was testimony that the Wheco and Bar Master devices were generally abandoned in favor of the Zilk device and its progeny when they became available on the market. However, as the Supreme Court has said, these factors are only "secondary considerations" which may provide "indicia of obviousness" where that issue is in doubt. *Graham v. John Deere, supra,* at p. 17, *Brooks Walker v. General Motors, supra,* p. 5. Where invention is clearly lacking in a particular device, the commercial success of such device cannot fill the void, that is to say, commercial success may not be taken as a substitute for invention. *Jaybee Manufacturing Corp. v. Ajax,* 287 F.2d 228. It cannot be used to raise a popular and needed device to the level of invention where as here obviousness is clear.

The Court therefore concludes that despite the fact that a small amount of objective evidence of non-obviousness was tendered, Cf. *Griffith Rubber Mills v. Hoffar, supra,* (and taking fully into account the factors of secondary consideration such as unsatisfied need and commercial success), the jury was unreasonable in finding that the Zilk patent was non-obvious. As a result the Zilk patent is invalid as a matter of law in that it clearly does not meet the statutory mandates established by 35 U.S.C. §103.

Entirely separate from the Section 103 issue, the Zilk concept does not meet the *A & P Tea Co.* standard of invention. The evidence in this case failed completely to

show that by the arrangement of old elements, plaintiff obtained any "unusual or surprising consequences" from his combination as called for in the *A & P Tea Co.* decision. (Reaffirmed in *Graham v. John Deere, supra.*) All that Zilk achieved was a more convenient location for the switch buttons permitting a one handed operation, which was possible with a single fluid in the "Wheco" device. It has long since been the law that mere relocation of an element of an old combination does not amount to patentable invention. *Photochart, et al v. Photo Patrol, et al,* 189 F.2d 265. *Weyerhauser Timber Co. v. Royal Container Co.,* 128 U.S.P.Q. 70, 71. This maxim holds true regardless of how useful or convenient the relocation is. *Cuno Corp. v. Automatic Devices Corp.,* 314 U.S. 84. This issue is so clear in light of the long line of judicial precedents that it may properly be resolved as a matter of law by the Court.[11]

Accordingly, the motion for judgment n.o.v. is GRANTED and judgment is entered for defendants.

Dated: May 12, 1966

Albert C. Wollenberg
United States District Judge

Costs taxed at $288.02

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[11]The *A & P Tea Co.* test was not submitted to the jury in the instructions as the standard for invention because of the confusion over the possible preemption by Section 103, preceding the *Graham* decision.

GENERAL FORM OF VERDICT

We, the Jury, find in favor of the plaintiffs, Carl S. Zilk and Flomatic Sales Corporation and assess damages against the defendants, Deaton Fountain Service, a partnership, William F. Deaton, and C. J. De Ceasare, in the sum of Twenty Six Hundred and Forty Dollars and No Cents ($2640.00) Dollars.

William T. Murphy
Foreman

Dated February 8th, 1966.
Filed Feb. 8, 1966, at 4 o'clock and 32 minutes P.M.

L. R. P
Deputy Clerk

FORM OF INTERROGATORIES

We, the jury in the above entitled action, unanimously find as follows:

Interrogatory:	Unanimous Answer of the Jury:
(1) Is there anywhere disclosed in the prior art as of July 19, 1957, the combination of elements recited in patent claim 1?	No [Yes or No]
(2) If the jury's answer to the above question (1) is NO, would the improvement or advance made by the patentee in his combination of elements recited in claim 1 have been obvious to one or ordinary skill in the art as of July 19, 1957?	No [Yes or No]
(3) Is there anywhere disclosed in the prior art as of July 19, 1957, the combination of elements recited in patent claim 2?	No [Yes or No]
(4) If the jury's answer to the above question (3) is NO, would the improvement or advance made by the patentee in his combination of elements recited in claim 2 have been obvious to one of ordinary skill in the art as of July 19, 1957?	No [Yes or No]
(5) Is there anywhere disclosed in the prior art as of July 19, 1957 the combination of elements recited in patent claim 3?	No [Yes or No]

Interrogatory:	Unanimous Answer of the Jury:
(6) If the jury's answer to the above question (5) is NO, would the improvement or advance made by the patentee in his combination of elements recited in claim 3 have been obvious to one of ordinary skill in the art as of July 19, 1957?	No [Yes or No]
(7) Is there anywhere disclosed in the prior art as of July 19, 1957, the combination of elements recited in patent claim 4?	No [Yes or No]
(8) If the jury's answer to the above question (7) is NO, would the improvement or advance made by the patentee in his combination of elements recited in claim 4 have been obvious to one of ordinary skill in the art as of July 19, 1957?	No [Yes or No]
(9) Is there anywhere disclosed in prior art as of July 19, 1957, the combination of elements recited in patent claim 5?	No [Yes or No]
(10) If the jury's answer to the above question (9) is NO, would the improvement or advance made by the patentee in his combination of elements recited in claim 5 have been obvious to one of ordinary skill in the art as of July 19, 1957?	No [Yes or No]

Interrogatory:	Unanimous Answer of the Jury:
(11) Is there anywhere disclosed in the prior art as of July 19, 1957, the combination of elements recited in patent claim 6?	No [Yes or No]
(12) If the jury's answer to the above question (11) is NO, would the improvement or advance made by the patentee in his combination of elements recited in claim 6 have been obvious to one of ordinary skill in the art as of July 19, 1957?	No [Yes or No]
(13) Is there anywhere disclosed in the prior art as of July 19, 1957, the combination of elements recited in patent claim 7?	No [Yes or No]
(14) If the jury's answer to the above question (13) is NO, would the improvement or advance made by the Patentee in his combination of elements recited in claim 7 have been obvious to one of ordinary skill in the art as of July 19, 1957?	No [Yes or No]
(15) Is there anywhere disclosed in the prior art as of July 19, 1957, the combination of elements recited in patent claim 8?	No [Yes or No]

Interrogatory:	Unanimous Answer of the Jury:
(16) If the jury's answer to the above question (15) is NO, would the improvement or advance made by the patentee in his combination of elements recited in claim 8 have been obvious to one or ordinary skill in the art as of July 19, 1957?	No [Yes or No]
(17) If the jury's answer to any two of the above interrogatories referring to a particular claim is NO in both instances (for example, Interrogatories (1) and (2), Interrogatories (3) and (4), etc.), does the Bar master dispenser which is Exhibit 4 in evidence infringe one or more of the claims of the patent in suit?	Yes [Yes or No]
(18) If the jury's answer to question (17) is YES, state the claim number or numbers which the Barmaster device does infringe.	1, 2, 3, 6, 7, 8
(19) If the jury's answer to any two of the above interrogatories referring to a particular claim is NO in both instances (for example, Interrogatories (1) and (2), Interrogatories (3) and (4), etc.), does the Carbonic dispenser which is Exhibit 5 in evidence infringe one or more of the claims of the patent in suit?	Yes [Yes or No]

Interrogatory:	Unanimous Answer of the Jury:
(20) If the jury's answer to question (19) is YES, state the claim number or numbers which the Carbonic device does infringe.	1, 2, 3, 4, 5, 6, 7, 8
(21) If the jury's answer to any two of the above interrogatories referring to a particular claim is NO in both instances (for example, Interrogatories (1) and (2), Interrogatories (3) and (4), etc.), does the McCann dispenser which is Exhibit 6 and S in evidence, infringe one or more of the claims of the patent in suit?	Yes [Yes or No]
(22) If the jury's answer to question (21) is YES, state the claim number or numbers which the McCann device does infringe.	1, 2, 3, 4, 5, 6, 7, 8
(23) Have the plaintiffs been damaged by the infringement of one or more of the claims of the patent in suit?	Yes [Yes or No]
(24) If the jury's answer to the above question (23) is YES, what is the amount of the actual or compensatory damages found by the jury to have been caused to plaintiffs by the defendants' infringement?	

Tuesday, February 8, 1966 1:35 o'clock p.m.

Afternoon Session

(Jury enters courtroom)

(Jury Instructions by Hon. Albert C. Wollenberg)

Ladies and gentlemen of the jury:

The presentation of the evidence in this case has been concluded and you have heard the arguments of counsel. It is now time for you to receive instructions as to the law applicable to the case. Thus, when you retire for deliberation, you will have had presented for your consideration the facts, the arguments, and now the law.

Although you as jurors are the sole judges of the facts, you are duty bound to follow the law as stated in my instructions and to apply the law so given to the facts as you find them from the evidence before you.

You are not to single out one instruction alone as stating the law but you must consider my instructions as a whole.

Neither are you to be concerned with the wisdom of any rule of law. Regardless of any opinion you may have as to what the law ought to be, it would be a violation of your sworn duty to base a verdict upon any other view of the law than as given to you in my instructions. Just as it is your exclusive power to determine the facts, it is my exclusive function to determine the law, which is given to you in the form of instructions, for application to the facts as you determine them to be.

Although I have authority to comment upon the evidence I have no intention of so doing in this action. The

jury is not to infer from anything that I may have said or done during the course of this trial a suggestion or hint as to what your verdict should be in this case. The responsibility in that regard is yours alone.

If in these instructions, any rule, direction or idea be stated in varying ways, no emphasis thereon is intended by me, and none must be inferred by you. For that reason, you are not to single out any certain sentence, or any individual point or instruction, and ignore the others, but you are to consider all of the instructions as a whole, and to regard each in the light of all the others.

During the course of a trial, I occasionally ask questions of a witness, in order to bring out facts not then fully covered in the testimony. Do not assume that I hold any opinion on the matters to which my questions related. Remember at all times that you, as jurors, are at liberty to disregard all of my comments made during the trial in arriving at your own findings as to the facts.

It is my duty to admonish an attorney who, out of zeal for his cause, does something which is not in keeping with the rules of evidence or procedure.

You are to draw no inferences against the side to whom any admonition of mine may have been addressed during the trial of this case.

It is the duty of attorneys on each side of a case to object when the other side offers testimony or other evidence which counsel believes is not properly admissible.

When I have sustained an objection to a question, the jury are to disregard the question, and may draw no

inference from the wording of it or speculate as to what the witness would have said if permitted to answer.

Upon allowing testimony or other evidence to be introduced over the objection of counsel, I do not, unless expressly stated, indicate any opinion as to the weight or effect of such evidence. As stated before, the jurors are the sole judges of the credibility of all witnesses and the weight and effect of all evidence.

If during this trial I have said or done anything which has suggested to you that I am inclined to favor the claims or position of either party, you will not suffer yourself to be influenced by any such suggestion.

I have not expressed, nor intended to express, nor have I intended to intimate, any opinion as to which witnesses are, or are not, worthy of belief; what facts are, or are not, established; or what inferences should be drawn from the evidence. If any expression of mine has seemed to indicate an opinion relating to any of these matters, I instruct you to disregard it.

You have been chosen and sworn as jurors in this case to try certain issues of fact presented by the allegations of the complaint of the plaintiffs, Carl S. Zilk and Flomatic Sales Corporation, and the answer thereto of the defendants, Deaton Fountain Service, William F. Deaton and C. J. DeCeasare.

You are to perform this duty without bias or prejudice as to any party. The law does not permit any jurors to be governed by sympathy, prejudice, or public opinion. The parties and the public expect that you will carefully and impartially consider all the evidence, follow the law

as I have stated it to you, and reach a just verdict, regardless of the consequences.

This case should be considered and decided by you as an action between persons of equal standing in the community of equal worth, and holding the same or similar stations in life. A corporation or partnership is entitled to the same fair trial at your hands as any private individual. The law is no respector of persons; all persons, including partnerships and corporations, stand equal before the law, and are to be dealt with as equals in a court of justice.

The burden is on the plaintiffs, Carl S. Zilk and Flomatic Sales Corporation, to prove every essential element of their case by a preponderance of the evidence. If the proof fails to establish any essential element of plaintiffs' case by a preponderance of the evidence then you should find for defendants, Deaton Fountain Service, William F. Deaton and C. J. DeCeasare.

To "establish by a preponderance of the evidence" means to prove that something is more likely so than not so. In other words, a preponderance of the evidence means such evidence as, when considered and compared with that opposed to it, has more convincing force and produces in your minds belief that what is sought to be proved is more likely true than not true.

There are, generally speaking, two types of evidence from which a jury may properly find the truth as to the facts of a case. One is direct evidence—such as the testimony of an eyewitness. The other is indirect or circumstantial evidence—the proof of a chain of circumstances

pointing to the existence or non-existence of certain facts.

As a general rule, the law makes no distinction between direct and circumstantial evidence, but simply requires that the jury find the facts in accordance with the preponderance of all evidence in the case, both direct and circumstantial.

Statements and arguments of counsel are not evidence in the case, unless made as an admission or stipulation of fact. When the attorneys on both sides stipulate or agree as to the existence of a fact, the jury must accept the stipulation as evidence and regard that fact as conclusively proved.

As the Court, I may take judicial notice of facts or events which are matters of common knowledge. When I declare that I will take judicial notice of some fact or event, the jury must accept my declaration as evidence and regard as conclusively proved the fact or event which I have judicially noticed.

The evidence in this case consists of the sworn testimony of the witnesses, all the exhibits which have been received in evidence, all facts which have been admitted or stipulated, all facts and events which have been judicially noticed, and all applicable presumptions stated in these instructions. Any evidence as to which I have sustained an objection, and any evidence which I have ordered stricken, must be entirely disregarded.

You are to consider only the evidence in the case. But in your consideration of the evidence you are not

limited to the bald statements of the witnesses. On the contrary, you are permitted to draw, from facts which you find to have been proved, such reasonable inferences as seem justified in the light of your own experience.

An inference is a deduction or conclusion which reason and common sense lead the jury to draw from facts which have been proved.

A presumption is a conclusion which the law requires the jury to make from particular facts, in the absence of convincing evidence to the contrary. A presumption continues in effect until overcome or outweighed by evidence to the contrary; but unless so outweighed the jury are bound to find in accordance with the presumption.

Unless and until outweighed by evidence to the contrary, the law presumes that a person is innocent of crime or wrong; that a witness speaks the truth; that an official duty has been regulary performed; that private transactions have been fair and regular; that the ordinary course of business has been followed; that things have happened according to the ordinary course of nature and the ordinary habits of life; and that the law has been obeyed.

Except in rare instances where a presumption is declared by law to be conclusive, a presumption can stand only so long as it is not overcome or outweighed by evidence to the contrary of the fact presumed.

It is a disputable presumption that a thing once proved to exist continues so long as is usual with things of that nature. So unless and until overcome or outweighed by

evidence to the contrary, the law presumes that a thing once proved to exist continues as long as is usual with things of that nature.

You, as jurors, are the sole judges of the credibility of the witnesses and the weight their testimony deserves. A witness is presumed to speak the truth. But this presumption may be outweighed by the manner in which the witness testifies, by the character of the testimony given, or by contradictory evidence. You should carefully scrutinize the testimony given, the circumstances under which each witness has testified, and every matter in evidence which tends to indicate whether the witness is worthy of belief. Consider each witness's intelligence, motive and state of mind, and demeanor and manner while on the stand. Consider also any relation each witness may bear to either side of the case; the manner in which each witness might be affected by the verdict; and the extent to which, if at all, each witness is either supported or contradicted by other evidence.

Inconsistencies or discrepancies in the testimony of a witness, or between the testimony of different witnesses, may or may not cause the jury to discredit such testimony. Two or more persons witnessing an incident or a transaction may see or hear it differently; and innocent misrecollection, like failure of recollection, is not an uncommon experience. In weighing the effect of a discrepancy, consider whether it pertains to a matter of importance or an unimportant detail, and whether the discrepancy results from innocent error or from willful falsehood. If you find the presumption of truthfulness to be outweighed as to any witness, you will give the testi-

mony of that witness such credibility, if any, as you may think it deserves.

A witness may be discredited or impeached by contradictory evidence; or by evidence that at other times the witness has made statements which are inconsistent with the witness's present testimony.

If you believe any witness has been impeached and thus discredited, it is your exclusive province to give the testimony of that witness such credibility, if any, as you may think it deserves.

If a witness is shown knowingly to have testified falsely concerning any material matter, you have a right to distrust such witness's testimony in other particulars; and you may reject all the testimony of that witness or you may give it such credibility as you may think it deserves.

While the burden rests upon the party who asserts the affirmative of an issue to prove his claim by a preponderance of the evidence, this rule does not require demonstration, or such degree of proof as produces absolute certainty, since in human affairs absolute certainty is seldom possible.

In a civil action such as this, it is proper to find that a party has succeeded in carrying all the burden of proof on an issue of fact if, after consideration of all the evidence in the case, the jurors believe that what is sought to be proved on that issue is more likely true than not true.

You are not bound to decide any issue of fact in accordance with the testimony of any number of witnesses

which does not produce in your minds belief in the likelihood of truth, as against the testimony of a lesser number of witnesses or other evidence which does produce such belief in your minds.

The test is not which side brings the greater number of witnesses, or presents the greater quantity of evidence, but which witness and which evidence appeals to your minds as being most accurate and otherwise trustworthy.

The testimony of a single witness which produces in your minds belief in the likelihood of truth is sufficient for the proof of any fact, and would justify a verdict in accordance with such testimony even though a number of witnesses may have testified to the contrary if, after fully considering all the evidence in the case, you hold greater belief in the accuracy and honesty of the one witness.

In determining the issues in this case you should consider all the evidence in the case regardless of who produced it. A party is entitled to the same benefit from evidence that favors his cause or defense when produced by his adversary as when produced by himself.

The plaintiffs in this case claim damages for alleged infringement of the patent in suit.

The patent in suit was originally applied for by Carl S. Zilk on September 16, 1958 as a continuation in part of an earlier application filed by him on November 12, 1957. The patent in suit, No. 2,887,250, was issued by the United States Patent Office on May 19, 1959.

Since all patents issued in the United States are for a term of 17 years, the patent in suit expires at the end of the 17-year period, on May 19, 1976.

The plaintiffs allege that the patent in suit is valid, and that the patent claims are infringed by the defendants. Because of the alleged infringement, the plaintiffs seek damages for the period commencing with the issuance of their patent on May 19, 1959 through the date of this trial.

The defendants deny that the patent in suit is a valid patent. The defendants also deny infringement of the patent claims. So, there are three questions presented:

First: Is the patent in suit a valid patent?

Second: If valid, did the defendants infringe the patent? and

Third: If the patent is valid, and if the patent is infringed by defendants, what damages should be awarded to plaintiffs for such infringement?

The first question presented to you is: Is the patent in suit a valid patent?

Here, the defendants have the burden of coming forward with convincing evidence to establish that the patent in suit is not valid. This is so, because the law gives to the holder of a patent the benefit of a presumption that the patent is valid. In other words, the law presumes, in the absence of convincing evidence to the contrary, that the Patent Office acted correctly in issuing the patent.

In other words, this presumption of validity continues in effect unless there is convincing evidence in the case which leads the jury to a different or a contrary conclusion.

Section 101 of Title 35 of the United States Code, dealing with the patent laws of the United States, provides that:

> "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements * * *" of the patent laws.

In this case, we are concerned only with the claimed invention of a machine—a dispensing device.

Among the conditions and requirements of the patent laws just referred to is the requirement of Section 111 of Title 35 of the United States Code that the application for patent shall be in writing, under oath, and shall contain a drawing, and a specification.

As to what must be included in the specification, in order for the patent to be valid, Section 112 of Title 35 of the United States Code provides in part that:

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out of his invention.
>
> "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

In other words, for a patent to be valid the patentee must have pointed out and claimed the particular improvement or combination which he claims to be his in-

vention or discovery in such manner as to distinguish it from prior devices.

Whenever a valid patent is issued by the Patent Office, the patent laws in effect give the inventor a seventeen year monopoly, in the manufacture, sale, and use of the invention, in return for a disclosure of the best manner or method contemplated by the inventor for the construction and operation of the machine.

This required disclosure is made a part of the letters patent, as issued and, as already stated, is known as the specification. The disclosure in the specification must contain "a written description of the invention, and of the manner and process of making and using it", and this description must set forth "in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains"—here the dispenser art—to make and use the device.

In other words, it is one of the conditions and requirements of the patent laws that the patent in suit must disclose sufficient information to teach a person, having ordinary skill in the dispenser art, how to make and use the device there claimed to have been invented.

The numbered claims of the patent mark the limits of the invention. The claims of the patent must define the particular thing invented, so that the public will know what that thing is, and so be able to avoid infringing.

The function of a patent claim is, therefore, not merely to outline or summarize what is shown and described in the written description and drawing of the patent, but rather to define the exact boundaries of the claimed in-

vention,—that is, to determine with precision, or to mark out clearly, the boundaries or limits of the claimed invention.

Neither the specification nor the drawings of a patent can be infringed; only the patent claims can be infringed.

Claim 1 of the patent in suit is typical and is the most broad of the patent claims. It defines a machine—namely, a dispensing device. As is the case in most machine patents, this claim recites a combination of mechanical elements and describes how these elements cooperate with one another. The claim, broken down element by element, is as follows:

> 1. A dispensing apparatus comprising a dispensing head having a nozzle, a handle for said head, a remotely located valve means to selectively regulate the supply of a plurality of fluids to said head, a plurality of flexible conduits extending from said valve means to said head and communicating with said nozzle to deliver said plurality of fluids to said nozzle, electric power means for said valve means for operating said valve means to selectively supply said fluids to said head, switch means carried by said handle to control the supply of electrical energy to said power means, flexible electrical conductors extending from said power means to said switch means to enable said control, means holding said conduits and flexible conductors together in contiguous relationship to provide a single flexible member enabling said head to be moved freely relative to said valve means, said handle having a shape fitting in one hand of the operator with the nozzle located adjacent to such hand, said switch means including a plurality of independently operable push buttons, each push button being oper-

able when actuated to control operation of the valve means to cause a supply of at least one selected fluid to said nozzle through said conduits, said push buttons being grouped on said handle to provide for operation of any push button by the thumb or a finger of said one hand of the operator without changing the grip of such one hand on the handle thus freeing the other hand of the operator for other uses while permitting the selective discharge of a plurality of fluids from said nozzle.

The defendants assert that the patent in suit, specifically the patent claims, are not valid for three reasons:

First, because the invention defined in the patent claims is not "new", as the word is used in the patent laws;

Second, because the invention defined in the patent claims "would have been obvious at the time the invention was made to a person having ordinary skill in the art" to which the claimed subject matter pertains;

Third, because the patent claims do not particularly point out and distinctly claim the subject matter which Mr. Zilk regards as his invention.

Section 102 of Title 35 of the United States Code outlines conditions for patentable novelty or what in patent law is considered "new". It provides, among other things, that one is entitled to a patent on a device if the device was not "known or used by others in this country", or was not "patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent" or if, before the applicant's invention of it, the same invention was

not "made in this country by another who had not abandoned, suppressed, or concealed it."

In other words, a patent claim for a device is "new", if, before the patentee's invention of it, the same combination of mechanical elements or the equivalents of those elements was not already known or used by others in the United States.

That which is known or used by others, invented by another, or patented or described in a printed publication prior to a patentee's invention is considered "prior art" in the patent law.

In determining what is "prior art" in a particular case, we look to the state of things as they existed at the time the claimed invention was made.

In this case, it is agreed that the claimed invention was made by Carl S. Zilk on July 19, 1957.

A person, who applies for a patent in a machine, is conclusively presumed to know about all the same or similar machines, which are disclosed in the "prior art"; and also to have knowledge of all the same or similar prior art machines which were publicly known, or used by anyone, regardless of whether, as a matter of fact, he actually knew of them or not. What was previously patented, or publicly described, or publicly used or known, as stated before, is collectively spoken of as "the prior art", or "the prior state of the art".

If an earlier patent discloses substantially the same things as the claims of a later patent, or if substantially the same things are already in existence, or publicly known, or used, before one makes a discovery that is

subsequently patented, the later patent is said to be anticipated by the prior state of the art, and is therefore invalid, since it is not "new".

The patent statutes passed by the United States Congress define the basic test of patentable invention as follows:

> a patent may not be obtained though the invention is not identically disclosed or described in the prior art, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having the ordinary skill in the art to which said subject matter pertains.

The patentability of an invention is in no way "negatived by the manner in which the invention was made".

It is possible to obtain a valid patent claim defining a combination of old elements, if the old elements are assembled, or combined, in a way not shown in the "prior art" or in such a way as to produce a new or advanced or improved result. That is to say, the combination, or assembly, of old elements is patentable if it is itself "new" or produces in some way or manner, a result which would not have been expected by a person having ordinary skill in the dispenser art.

As applied to this case, the test is whether the combination, or assembly of mostly old elements in a dispenser was a new combination of those old elements, and one which would not have been obvious to a person having ordinary skill in the art, who set about to design

and build an improved dispenser at the time of the claimed invention.

Invention is the double mental act of discerning some deficiency or need and pointing out or finding the means of overcoming it.

The fact that the combination of elements is simple or the individual elements of the combination may be easily obtained on the open market or easily assembled does not negative the patentability of the claimed combination.

And similarly, commercial success of a device or perfection of workmanship, however much it may increase the convenience, and extend the use or diminish expense, does not make a combination of elements patentable.

If you find that the differences between the claimed Zilk invention and the "Wheco" or "Magic Wand" devices are such that the claimed Zilk invention, as a whole would have been obvious, in July of 1957, to a person of ordinary skill in the bar dispensing art, you shall hold the Zilk patent invalid and return a verdict for the defendants.

As already stated, the granting of a patent by the United States Patent Office carries with it a presumption that the patent is valid. That is to say, from the mere issuance of the letters patent, it is presumed that the claimed invention provides something which is "new" and "useful", and amounts to a "discovery or invention" over what was already known in the prior art.

However, this presumption of validity which amounts to a presumption of invention, extends only to the record before the examiners in the Patent Office.

In other words, where the "file wrapper" of the patent discloses that an earlier patent was considered by the Patent Office during the prosecution of the application for the patent, there is a presumption that the Patent Office Examiner did find differences amounting to invention between the prior art patent so considered, and the patent later issued.

In this case, for example, the fact that the Brown, Parks and Welsh patents were considered by the Patent Office Examiner carries with it the presumption that the combination of old elements, in the patent in suit, produces a result that amounts to an invention over what is disclosed in these patents. But, as to the prior art, which does not appear from the record of the "file wrapper" to have been considered by the Patent Office—no such presumption exists.

In other words, there is no presumption of validity over prior art patents and structures which the Patent Office did not consider.

This presumption of validity, as I have previously stated, is merely a rule of evidence which requires anyone who disputes the validity of a patent, to come forward with convincing evidence that the Patent Office was wrong, in distinguishing what is shown in the prior art from what is shown in the patent in suit.

A single item of prior art not considered by the Patent Office may be sufficient to show that the Patent Office was wrong.

It is admitted that certain prior art was not listed as having been considered by the Examiner in the United

States Patent Office, during the examination and study of the application on which the patent in suit issued in 1959.

The prior art in evidence, which was not considered by the Patent Office, is the following:

> The "Wheco" device or "Speed Bar" device, and the "Bar-O-Matic" plus the "Magic Wand" device.

The Patent Office Examiner may have failed to note the prior patent art as represented by the prior art patents which are all contained in Exhibits O with their numerical numbers under O in the "file wrapper" record of the patent in suit for many reasons.

He may not have thought that the art was sufficiently close or akin to the invention claimed in the patent in suit. Or this prior art may not have been called to the attention of the Examiner. Or he may have overlooked them through oversight or other error. At least the Examiner did not cite them nor make them of record herein in any way.

There, of course, cannot be any infringement of an invalid patent. However, if you unanimously find one or more of the claims of the patent in suit to be valid, it then will become your duty to proceed to consider and decide the issue of infringement. So, the next question before you is: Do any of the "accused devices" infringe any valid claim of the patent in suit?

The "accused devices", as you have been told during the trial, are in "Exhibits 4, 5, 6, and S", which are the bar mix dispensers admittedly used and sold by the de-

fendants which are alleged by the plaintiffs to infringe each of the claims of the patent in suit.

Whoever, without authority or license or other permission from the owner of a valid patent, uses or sells the patented invention anywhere in the United States, during the term of the patent therefor, infringes the patent.

A person may infringe a patent without any intent to do so. Indeed, a person may infringe a valid patent without actual knowledge of the existence of the patent; and without knowing that what he is doing is an infringement; and even though he may in good faith believe that what he is doing is not an infringement of any patent.

In order to prove infringement, the plaintiffs must establish, by a preponderance of the evidence, that the alleged infringing dispensers—that is the "accused devices"—embody every essential element of the invention set forth in one or more of the claims of the patent in suit, found by you to be valid, since the claim is required by law to define the subject matter which the patentee regards as his invention.

If an "accused device" functions without one of the parts or elements claimed in the patent in suit to be an essential element of the invention, then there is no infringement, unless it can be said that one or more elements of an "accused device" is the substantial equivalent of that omitted element.

This is but another way of saying that, before the "accused devices" can be correctly said to infringe, each must operate to accomplish substantially the same result,

in substantially the same way, and by substantially the same means, as does the invention defined in one or more claims of the patent in suit found to be valid.

The meaning of "substantial" or "substantially" must always depend upon the character of the invention involved. If an invention achieves a major or extraordinary advance over the prior state of the art, and as such may properly be characterized as a "pioneer invention", then the term "substantial" includes what we call a broad or liberal range of equivalent elements. On the other hand, if the invention's advance over the prior art is a narrow or minor one, the meaning of the term "substantially equivalent" is correspondingly narrow, and ordinarily means practically "identical".

If the jury should find, from a preponderance of the evidence in the case, that any of the "accused devices" does infringe any valid claim of the patent in suit, you must then proceed to consider and determine the issue of damages.

On the other hand, if the jury should find in favor of the defendants on the issue of infringement, then the jury should return a verdict in favor of the defendants on the issue of infringement.

The fact that I will now instruct you as to the proper measure of damages should not be considered as intimating any view of mine as to which party is entitled to your verdict in this case. Instructions as to the measure of damages are usually given to the jury so that the jury will have the necessary instructions available if it reaches the damage issue.

If the jury should find, from a preponderance of the evidence in the case, that the plaintiffs are entitled to a verdict on the issue as to infringement of one or more claims of the patent in suit found by the jury to be valid, the law provides that the plaintiffs are to be fairly compensated for all damage, if any, caused by the defendants' infringement.

These damages must be actual damages as distinguished from speculative damages.

The actual damages to the plaintiffs caused by infringement should be determined on the basis of what the jury finds, from a preponderance of the evidence in the case, would have been a reasonable royalty to be paid for a license to use the invention during the period of the infringement.

A reasonable royalty is the amount which the owner of a patent would accept, who is desirous of licensing another to use his patent in return for a royalty, but who is not forced by financial need or other compulsion to do so; and the amount which a person would be willing to pay as royalty, who is desirous of obtaining a license to use the invention, but who is not compelled to do so. In other words, a reasonable royalty is the amount which you find those two free and uncompelled and uncoerced bargainers would agree upon.

In determining a reasonable royalty, the jury are entitled to consider any evidence in the case as to profits the defendants may have realized from the infringement as well as the costs of manufacture, costs of marketing, sales prices, demand, and so forth.

The law permits the owner of a patent to state what he would accept as a reasonable royalty.

In determining the issue as to damages, you should bear in mind that the law does not permit the jury to award any greater sum than the monetary loss which the plaintiffs have suffered as a result of the defendants' infringement, without regard to whether the defendants have gained or lost by the infringement.

The law forbids you to determine any issue in this case by resort to chance. You will understand this principle of law better, perhaps, if I give you an illustration:

> Suppose that after jurors have decided that a plaintiff is entitled to recover, they agree that each juror shall write down or state an amount of damages that he believes should be awarded, that all such amounts shall be totaled, and the total divided by twelve to find an average, and that the average so found shall be the amount of the verdict.
>
> To use a method of this kind would be to determine the issue of damages by chance and it is unlawful, and you must not do it.

The verdict must represent the considered judgment of each juror. In order to return a verdict, it is necessary that each juror agree thereto. Your verdict must be unanimous.

It is your duty, as jurors, to consult with one another and to deliberate with a view to reaching an agreement, if you can do so without violence to individual judgment. Each of you must decide the case for yourself, but do so

only after an impartial consideration of the evidence with your fellow jurors.

In the course of your deliberations, do not hesitate to reexamine your own views and change your opinion if convinced it is erroneous. But do not surrender your honest conviction as to the weight or effect of evidence solely because of the opinion of your fellow jurors, or for the mere purpose of returning a verdict.

It is proper to add a caution that nothing said in these instructions—nothing in any form of verdict prepared for your convenience, is to suggest or convey in any way or manner any intimation as to what verdict I think you should find. What the verdict shall be is the sole and exclusive duty and responsibility of you ladies and gentlemen of the jury.

Upon retiring to the jury room, you will select one of your number to act as your foreman or forelady. And your foreman or forelady will preside over your deliberations and will be your spokesman here in court.

A form of interrogatories and forms of general verdict have been prepared for your convenience. You may take these forms to the jury room and I direct your attention to them at this time.

There have been prepared a total of twenty-four interrogatories for you to answer.

In that general form, they are direct questions of you, as follows:

> "1. Is there anywhere disclosed in the prior art as of July 19, 1957, the combination of elements recited in patent claim 1?"

Now, I read you that as an illustration.

From then we go on and each question is simple and direct. I give them to you in this form and I ask you to respond to them in the right hand column that is provided for your answer.

You will note that the form contains twenty-five questions. You will note also that these interrogatories except as to 18, 20, and 22 and 25 call for a simple "Yes" or "No" answer. The answer to each question must be the unanimous answer, of course, of the ladies and gentlemen of the jury. Your foreman or forelady will write whatever the answer may be of the jury in the space provided opposite the question, and then date and sign the interrogatories when they are completed. You should sign on the last page of the margin thereof.

As you will note from the wording of the questions, it may or may not be necessary to consider and answer all of the questions in the form of the interrogatories.

The first question calls for you to make a "Yes" or "No" finding as to whether the prior art as of July 19, 1957, anywhere discloses the combination of elements recited in patent claim number 1.

If your answer to Interrogatory 1 is "No", you must answer Interrogatory 2 which calls for you to make a "Yes" or "No" finding as to whether the improvement or advance in the combination of elements recited in claim 1 would have been obvious to one of ordinary skill in the art as of July 19, 1957.

The next group of questions are similar except that they relate to other claims in the patent.

If for any one or more of the eight claims your answers to interrogatories pertaining to a claim have been answered "No", then you must answer Interrogatory 17 which calls for your finding as to whether any claim of the patent in suit has been infringed by the Bar Master device which is Exhibit 4. If your answer to Interrogatory 17 is "Yes", you must specify in Answer 18 which claims are infringed.

Similarly, if for any one or more of the eight claims your answers to both interrogatories pertaining to a claim have been answered "No", then you must answer Interrogatory 21 which calls for you to make a finding as to whether the patent in suit has been infringed by the McCann dispenser which is Exhibit 6. If your answer to Interrogatory 21 is "Yes", you must specify in Answer 22 which claims are infringed.

Upon completion of all answers required in the form of interrogatories, you will fill in, date and sign one form of general verdict which sets forth the verdict upon which you unanimously agree, and return to the courtroom.

If it becomes necessary during your deliberations to communicate with the Court—that is with me, you may send a note in by the bailiff. Never attempt to communicate by any other means than a signed writing. And bear in mind that you are not to reveal to me or to any person how the jury stands, numerically or otherwise, until you have reached your unanimous verdict.

Now, we also have prepared two forms of general verdict for your convenience and they read as follows:

"We, the Jury, find in favor of the plaintiffs, Carl S. Zilk and Flomatic Sales Corporation and assess damages against the defendants, Deaton Fountain Service, a partnership, William F. Deaton, and C. J. De Ceasare, in the sum of _____Dollars."

We also have prepared another form and it reads as follows:

"We, the Jury, find in favor of the defendants, Deaton Fountain Service, a partnership, William F. Deaton, and C. J. De Ceasare and against the plaintiffs, Carl S. Zilk and Flomatic Sales Corporation."

You will use either one or the other form of general verdict whichever expresses your verdict in the matter.

I will now give to the clerk these two forms of general verdict and also the form of interrogatories that was prepared.

SCHEDULE OF REPORTED JURY PATENT INFRINGEMENT ACTIONS (1952-1967)

I. Cases in which a patentee was deprived of a jury verdict.

A. Cases in which the jury found the patent valid and infringed, the District Court entered judgment on the verdict, and the Court of Appeals reversed on the ground of invalidity.

1. *Packwood v. Briggs & Straiton Corp.* (3 Cir. 1952), 195 F.2d 971, reversing *Packwood v. Briggs & Stratton Corp.* (D.Dela. 1951), 99 F.Supp. 803, cert.den. (1952), 344 U.S. 844, reh.den. (1952), 344 U.S. 882;
2. *Lunn v. F. W. Woolworth Co.* (9 Cir. 1953), 207 F.2d 174, cert.den. (1953), 346 U.S. 900, reh.den. (1954), 346 U.S. 928 (Mr. Justice Black was of the opinion that certiorari should be granted);
3. *Hygienic Specialties Co. v. H. G. Salzman, Inc.* (2 Cir. 1962), 302 F.2d 614, reversing *Hygienic Specialties Co. v. H. G. Salzman, Inc.* (S.D.N.Y. 1960), 189 F.Supp. 790; and
4. *Griffith Rubber Mills v. Hoffar* (9 Cir. 1963), 313 F.2d 1.

B. Cases in which the jury found the patent valid and infringed, the District Court entered judgment for the defendant notwithstanding the verdict on the ground of invalidity, and the Court of Appeals affirmed.

1. *Himes v. Chadwick* (9 Cir. 1952), 199 F.2d 100;

2. *Fraver v. Studebaker Corp.* (3 Cir. 1953), 208 F.2d 794, affirming *Fraver v. Studebaker Corp.* (W.D.Penn. 1953), 112 F.Supp. 209, cert.den. (1954), 347 U.S. 968, reh.den. (1955), 348 U.S. 939;

3. *Fischer & Porter Co. v. Brooks Rotameter Co.* (3 Cir. 1954), 211 F.2d 400, affirming *Fischer & Porter Co. v. Brooks Rotameter Co.* (E.D.Penn. 1952), 107 F.Supp. 1010, cert. den. (1954), 348 U.S. 871;

4. *Nachtman v. Jones & Laughlin Steel Corporation* (3 Cir. 1956), 235 F.2d 211, affirming *Nachtman v. Jones & Laughlin Steel Corp.* (W.D.Penn. 1955), 134 F.Supp. 392, cert.den. (1957), 352 U.S. 971;

5. *Stallman v. Casey Bearing Company* (9 Cir. 1957), 244 F.2d 905, affirming *Stallman v. Casey Bearing Company* (N.D.Cal.S.D. 1956), 144 F.Supp. 927, cert.den. (1957), 355 U.S. 864;

6. *Churchill Meat Company v. Brodsky* (3 Cir. 1958), 262 F.2d 77, affirming *Churchill Meat Company v. Brodsky* (D.N.J. 1958), 160 F.Supp. 241;

7. *Bentley v. Sunset House Distributing Corp.* (9 Cir. 1966), 359 F.2d 140; and

8. *Zilk v. Deaton Fountain Service* (9 Cir. 1967), ____ F.2d ____, affirming *Zilk v. Deaton Fountain Service* (N.D.Cal.S.D. 1966), 257 F.Supp. 458.

C. Case in which the jury found the patent valid and infringed, the District Court entered judgment for defendant notwithstanding the verdict on the ground of invalidity, and an appeal is pending.

1. *Swofford v. B & W, Inc.* (S.D.Tex. 1966), 251 F.Supp. 811.

D. Cases in which the District Court at the conclusion of the patentee's case in chief directed the jury to return a verdict in favor of defendant or dismissed the action on the ground of invalidity and the Court of Appeals affirmed.

1. *Berkeley Pump Co. v. Jacuzzi Bros.* (9 Cir. 1954), 214 F.2d 785;

2. *Klein v. Burns Manufacturing Co.* (2 Cir. 1957), 245 F.2d 269; and

3. *O'Brien v. Westinghouse Electric Corporation* (3 Cir. 1961), 293 F.2d 1.

E. Case in which the District Court struck a demand for a jury trial and held a court trial resulting in a holding of invalidity, and the Court of Appeals affirmed.

1. *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Sup. Co.* (6 Cir. 1964), 332 F.2d 406, affirming *Monroe Auto Equip. Co. v.*

Heckethorn Mfg. & Supply Co. (W.D.Tenn. W.D. 1963), 214 F.Supp. 704, cert.den. (1964), 379 U.S. 888.

F. Case in which the jury found the patent valid and infringed, the District Court found noninfringement and granted judgment for defendant notwithstanding the verdict, and the Court of Appeals either dismissed the appeal or affirmed.

1. *Patent Scaffolding Co. v. Up-Right, Inc.* (9 Cir. 1952), 194 F.2d 457, cert.den. (1952), 343 U.S. 958; and

2. *Reachi v. Edmond* (9 Cir. 1960), 277 F.2d 850, affirming *Reachi v. Edmond* (S.D.Cal. C.D. 1959), 121 USPQ 125.

II. Cases in which a patentee was awarded judgment pursuant to a jury verdict.

A. Cases in which the jury returned a verdict in favor of the plaintiff, the District Court entered judgment accordingly, and the Court of Appeals affirmed.

1. *Oxnard Canners v. Bradley* (9 Cir. 1952), 194 F.2d 655, cert.den. (1952), 343 U.S. 978; and

2. *Beatty Safway Scaffold Co. v. Up-Right, Inc.* (9 Cir. 1962), 306 F.2d 626, cert.den. (1963), 372 U.S. 934.

B. Case in which the jury found the patent valid and infringed, the District Court entered judgment notwithstanding the verdict for defendant on the ground of invalidity, and the Court of Appeals reversed finding the patent valid.

1. *National Sponge Cushion Co. v. Rubber Corp. of Cal.* (9 Cir. 1961), 286 F.2d 731, reversing *National Sponge Cushion Co. v. Rubber Corp.* (S.D.Cal.C.D. 1959), 128 USPQ 325, cert.den. (1962), 368 U.S. 976.

III. Case in which the defendant was awarded judgment pursuant to the jury verdict.

A. Case in which the jury found the patent valid but not infringed, the District Court entered judgment of non-infringement accordingly, and the Court of Appeals affirmed.

1. *R. H. Baker & Co. v. Smith-Blair, Inc.* (9 Cir. 1964), 331 F.2d 506, affirming *Smith-Blair, Inc. v. R. H. Baker & Co.* (S.D.Cal. C.D. 1962), 232 F.Supp. 484.

IV. Cases in which a new trial was awarded.

A: Case in which the jury found the patent valid and infringed, the District Court entered judgment for defendant on the ground of invalidity notwithstanding the verdict and in the alternative ordered a new trial, and the Court of Appeals reversed the judgment for defendant, but granted the alternative motion for a new trial.

1. *Moist Cold Refrigerator Co. v. Lou Johnson Co.* (9 Cir. 1957), 249 F.2d 246, cert.den. (1958), 356 U.S. 968.

B. Case in which the jury failed to agree, the District Court granted a motion for a directed verdict on the ground of invalidity, and the Court of Appeals remanded for a new trial.

1. *Hansen v. Safeway Stores* (9 Cir. 1956), 238 F.2d 336.

C. Case in which the jury found non-infringement, the District Court entered judgment accordingly, and the Court of Appeals reversed awarding a new trial on the ground that the District Court improperly excluded certain testimony.

1. *Thurber Corporation v. Fairchild Motor Corporation* (5 Cir. 1959), 269 F.2d 841.

D. Case in which the jury found non-infringement, the District Court granted a new trial, and the Court of Appeals denied review seeking to expunge the new trial order and to reinstate the judgment.

1. *General Motors Corporation v. Perry* (7 Cir. 1962), 303 F.2d 544.

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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1967

No. 377

CARL S. ZILK and FLOMATIC SALES CORPORATION, an Oregon corporation,
Petitioners,

vs.

DEATON'S FOUNTAIN SERVICE, a partnership comprised of William P. Deaton and C. J. De Ceasare,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

QUESTIONS PRESENTED

This case is not an appropriate case for determination by this Court of the Seventh Amendment, or right to trial by jury, questions set forth in the Petition because the judgments of the Courts below are supportable on a second, or non-jury case, ground.

The second ground for the District Court's judgment is as follows (Pet. App. 12a-13a):

"Entirely separate from the Section 103 issue, the Zilk concept does not meet the *A & P Tea Co.* standard of invention. The evidence in this case failed completely to show that by the arrangement of old elements, plaintiff obtained any 'unusual or surprising consequences' from his combination as called for in the *A & P Tea Co.* decision. (Reaffirmed in *Graham v. John Deere, supra.*) All that Zilk achieved was a more convenient location for the switch buttons permitting a one handed operation, which was possible with a single fluid in the 'Wheco' device. It has long since been the law that mere relocation of an element of an old combination does not amount to patentable invention. *Photochart, et al. v. Photo Patrol, et al.*, 189 F.2d 265. *Weyerhauser Timber Co. v. Royal Container Co.*, 128 U.S.P.Q. 70, 71. This maxim holds true regardless of how useful or convenient the relocation is. *Cuno Corp. v. Automatic Devices Corp.*, 314 U.S. 84. This issue is so clear in light of the long line of judicial precedents that it may properly be resolved as a matter of law by the Court.[11]

[11]"The *A & P Tea Co.* test was not submitted to the jury in the instructions as the standard for invention because of the confusion over the possible preemption by Section 103, preceding the *Graham* decision."

The District Court thereby held that the invention of the Zilk patent in suit was a combination of merely old elements (see also: Pet. App. 9a, ll. 14-20).

The judgment (Pet. App. 3a) of the Court of Appeals affirmed the judgment of the District Court without qualification, but in the Court of Appeals' *Per Curiam* opinion (Pet. App. 1a-2a) the second ground, *supra,* for the District Court's judgment is not mentioned. It is appropriate for Respondent here to urge the District Court's first

ground, *infra,* and its second ground, *supra,* in support of the judgment of the Court of Appeals. *Langnes v. Green,* 282 U.S. 531, 538.

The question is whether said second ground is a valid one after the time of the 1952 enactment of the non-obviousness requirement of Section 103, i.e. does the pre-1952-enunciated *A & P Tea Co.* test or standard of patentability for inventions which are combinations of old elements, the test requiring a showing of "unusual or surprising consequences", still have validity?

The *A & P Tea Co.* test concerned the *general level of innovation* to sustain patentability of a particular type of invention, i.e. a combination of old elements. That this test has post-1952 validity is indicated by this Court in *Graham v. John Deere Co.,* 383 U.S. 1, as follows:

> "We have concluded that the 1952 Act was intended to codify judicial precedents embracing the principle long ago announced by this Court in *Hotchkiss v. Greenwood,* 11 How. 248 (1850), and that, while the clear language of § 103 places emphasis on an inquiry into obviousness, the general level of innovation necessary to sustain patentability remains the same."

If the *A & P Tea Co.* has present validity, it follows that the Petition should be denied because the two questions in the Petition are moot.

The Petition should be so denied because the failure to instruct the jury (Pet. App. 13a, fn. 11) on the issues presented by the applicable standard of invention, the *A & P Tea Co.* test, amounted to a waiver of jury trial as to these issues. Stated otherwise, compliance or non-

compliance with this standard of invention did not in this case amount to a fact tried by the jury. Thus, the Seventh Amendment to the Constitution could not have barred the District Court from examining into the fact issues raised by the applicable standard of invention.

It is to be noted that the District Court's instructions concerning inventions which are combinations of old elements (Pet. App. 35a) fell far short of being instructions appropriate under the *A & P Tea Co.* test.

STATEMENT OF THE CASE

The following is set forth by way of addition to Petitioners' Statement of the Case.

In July, 1957, Petitioner Zilk was engaged in the bar dispenser business in Portland, Oregon. At that time, one of his competitors was selling the "Wheco" device, and Petitioner Zilk was personally acquainted with that device. The "Wheco" device, as explained in the District Court's opinion (Pet. App. 9a-10a), involved *one-handed* dispensing of individual bar mixes because it contained operating levers mounted at the movable ends of separate hoses (Tr., Vol. 2, pp. 53-55).

In July, 1957, Petitioner Zilk was visited by a salesman, who offered to sell a new device to him. The new device was the "Magic Wand". The "Magic Wand" had several hoses bound together into a single composite hose so that it could dispense several bar mixes, but it required *two hands* to operate it because the push buttons for the bar mixes were mounted on the stationary end of

the composite hose instead of the movable end thereof (Tr., Vol. 2, pp. 81-87).

Zilk's immediate reaction, upon seeing the "Magic Wand", was that its push buttons should be moved to the movable end of the hose to make the device competitive with the "Wheco" device (Tr., Vol. 2, pp. 82 and 83).

That is the invention for which the Zilk patent was granted. The Zilk invention is the prior art "Magic Wand" device with its electrical push buttons relocated from the stationary end of the hose to the movable end of the hose. A variety of prior art references, in addition to "Wheco", taught the technique of relocating electrical switches onto the movable ends of dispenser hoses (Pet. App., p. 11a, fn. 10).

The District Court concluded, as its first ground for the judgment, that the jury verdict was contrary to law in that no jury of reasonable-minded people could find that the Zilk invention was unobvious (Pet. App., p. 12a). The Court of Appeals affirmed with a one-paragraph *Per Curiam* opinion.

REASONS FOR DENYING THE WRIT

The District Court held that, considering the scope and content of the prior art, the claims at issue, and the level of ordinary skill in the art, for lack of probative evidence no reasonable-minded jury could have concluded that the Zilk invention was non-obvious to one skilled in the bar-dispensing art in July, 1957 (Pet. App. 7a).

The Court of Appeals agreed with the District Court, holding that there could have been but one reasonable

conclusion as to the verdict, i.e. that the Zilk patent was invalid for obviousness under Section 103, and pointing out that the record evidence which bore upon and supported the finding of obviousness under Section 103 was *uncontradicted* (Pet. App. 1a-2a).

Thus, both Courts below were consistent in finding and adjudging that the only reasonable conclusion as to the verdict was that the Zilk patent was invalid.

Petitioners urge this Court to take review of the matter on the premise that the Courts below were both wrong in mutually concluding that there was no evidentiary basis upon which reasonable men could conclude the presence of patentable invention, i.e. Petitioners argue to this Court "that the record furnishes an evidentiary basis upon which reasonable men could conclude the presence of invention" (Pet. 8).

Thus, in essence, Petitioners are asking this Court to undertake review of concurrent findings of fact by the two Courts below. Such a request is inappropriate in the absence of a very obvious and exceptional showing of error. *Graver Mfg. Co. v. Linde Co.*, 336 U.S. 271, 275.

Petitioners suggest the presence of error both as to findings of fact and as to propositions of law.

First, as to errors of law, Petitioners contend that a factual issue must at all times remain with the jury, i.e. that matters of law are for the Court and matters of fact are for the jury, and that under no circumstances can a Court rule on, or decide, a matter of fact as a matter of law. Petitioners totally ignore the true function of a jury and the significance of the case authorities they, the Petitioners, cite.

Thus, Petitioners overlook this basic reality: a factual issue ceases to be a factual issue, and thus its resolution ceases to be within the province of the jury, when there is no probative evidence to enable a jury composed of people of reasonable mind to resolve the issue in the way in which it did resolve it. Under such circumstances, the jury's verdict is beyond the role and function of the jury and is a usurpation of the Court's function. In this connection, there is no room for any contention that the Seventh Amendment provides an absolute guarantee of trial by jury of factual issues. The Seventh Amendment provides that a fact tried by a jury *can* be reexamined by a Court "according to the rules of the common law".

The rules of the common law permitted the Court to reexamine a fact tried by the jury and enter judgment *non obstante veredicto* where reasonable-minded men could not render the same verdict as the jury on the basis of the fact tried.

Petitioners urge this Court that no Court may take a Section 103 obviousness issue away from a jury. This urging is implicit in the two questions presented, and is explicit in the Petition (Pet. 9), whereat Petitioners take the position that in a jury-patent case, where there are differences between the prior art and the patented device, invention is a question of fact and is within, and must remain within, the sole domain of the jury.

Petitioners thereby urge this Court that a Court is not empowered to take the "obviousness" issue away from the jury, even when, as for example, the patented device may be a 1967 "Ford" with five wheels and when the

prior device may be a 1966 "Ford" with four wheels, the invention residing in the added wheel.

If the Petitioners are seriously urging an error of law, they are disserving this Court, the jury system, and the patent system. In fairness to Petitioners, it must be concluded that they are in reality urging an error only as to findings of fact, and the question then is, in the light of the concurrent findings of the Courts below, whether there is any "very obvious and exceptional" error.

It will be noted that the two questions posed by Petitioners are disposed within and conditioned by the framework of "a setting" (Pet. 2), the "setting" consisting of the following generalized findings of the District Court:

(1) there were differences between the patented device and the prior art;

(2) there was an unsatisfied need;

(3) the patented device attained commercial success;

(4) the most pertinent prior art devices were generally abandoned in favor of the patented device and its progeny when they became available on the market; and

(5) a small amount of objective evidence of non-obviousness was tendered.

In appropriate numerical sequence relative to the above-numbered items, what the District Court specifically found was as follows (Pet. App. 4a-13a):

(1) the patented device enabled a bar-tender to dispense in prompt succession any customer-required

order of a limited number of drink mixes, i.e. soda, tonic water, straight water, ginger ale, etc., by way of a one-handed operation, thereby leaving the bartender's other hand free for further pursuits in his employer's interest; the only notable difference between the Zilk device and the two prior art devices relied upon by the Court was the one-handed selective dispensing (multi-hose nozzle with plural push buttons) of a plurality of fluids without the necessity of changing the grip of that hand, i.e. this "notable difference" being in the light of (a) the prior art "Magic Wand" device enabling a one-handed dispensing of a plurality of bar mixes from a single, multi-hose nozzle while requiring the use of the other hand to operate plural push buttons disposed on a bar-mounted console; and (b) the prior art "Wheco" device which enabled a one-handed dispensing (a number of separate hoses, each connected to its own mix supply and each having a nozzle provided with a single push button, or valve control) of any selected bar-mix without requiring the use of the other hand;

(2), (3) and (4) as to unsatisfied need, commercial success, and replacement of the prior art devices by the patented devices, the District Court held that these were factors of secondary consideration which could provide indicia of non-obviousness where the issue of non-obviousness is in doubt, i.e. where reasonable-minded men could differ in their resolution of this issue;

(5) the small amount of objective evidence of non-obviousness tendered was (Tr., Vol. 1, pp. 132-135): prior to the Zilk invention, there was a prior art multi-mix dispensing device having a dispensing head adapted to be mounted in a stationary position on a bar and having a dispensing nozzle and plural push buttons on the head; this device, called a "Mix-O-Matic" dispenser, was made by Bar Master, the eventual producer of the above-discussed "Magic Wand" device; an optional version of this "Mix-O-Matic" device was offered at the same time to the trade, the optional version differing from the main form of device in that the buttons on the stationary head were replaced by a plurality of foot treadle switches; this freed both of the bartender's hands from the operation of the dispensing head and rendered the optional version operable by a one-armed bar tender; Petitioners argued to the Courts below that the removal of the push buttons from the dispensing head and the replacement of them by foot treadle switches indicated that it was obvious to modify the "Magic Wand" device by removing the push buttons from the stationary bar console and replacing them by foot treadle switches, and that this rendered it less obvious to modify the device by transfer of the push buttons from the console to the portable head; Petitioners' line of argument to the Courts below overlooked the fact that, if there are two clearly and equally obvious ways of doing something, one way is not rendered less obvious if a given person should elect to pursue the other way.

A further reason for denying the writ is set forth in the "Questions Presented" section of this brief, i.e., the second ground for the District Court's judgment was a non-jury ground, thereby rendering moot the two "jury trial" questions set forth in the Petition.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that the Petition should be denied.

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Respectfully submitted,
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